UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,049	05/29/2001	Kai Nyman	944-006.006-1	7666

4955 7590 01/15/2008

WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP
BRADFORD GREEN, BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER	
DAVIS, ZACHARY A	

ART UNIT	PAPER NUMBER
2137	

MAIL DATE	DELIVERY MODE
01/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/867,049	**Applicant(s)** NYMAN ET AL.	
	Examiner Zachary A. Davis	**Art Unit** 2137	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
 a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

 NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive.
In particular, regarding the rejection of Claims 1-10, 13, 14, 25-31, 35, 37-47, and 50-56 under 35 U.S.C. 103(a) as unpatentable over Berggren, WO00/44130, in view of Turtiainen, US 6430407, and Bilgic et al, US 6097817, and also of Claims 11, 12, 48, and 49 under 35 U.S.C. 103(a) as unpatentable over Berggren in view of Turtiainen and Bilgic and further in view of Lightman et al, US 6711414, in particular with reference to independent Claim 1, Applicant appears to have misread a statement in the previous Office action. Specifically, Applicant alleges that the Office action "states that the SIM card (160) IS A PART of the terminal (262)" (page 3 of the present response, emphasis in original, citing page 3 of the previous Office action); however, the Office action did not state that the SIM card was a part of the terminal (which corresponds to the claimed client), but instead stated that the SIM card is a part of the mobile station (corresponding to the claimed mobile station). Therefore, this argument is spurious because it is based on a misapprehension of the interpretation of the Berggren reference. Applicant asserts that "the SIM card (160) is NOT separate from the terminal (262)" (page 3 of the present response, emphasis in original); however, the Examiner respectfully disagrees, since the SIM card is part of the mobile station and not the terminal, and therefore is separate from the terminal. It is noted that the further arguments regarding Berggren (see pages 2-3 of the present response) are similar to the previous arguments asserting that Berggren does not disclose receiving at the client the subscriber identity sent from the mobile station. In response, the Examiner again notes that at least the cited portion of Berggren does disclose receiving at the client the subscriber identity sent from the mobile station, as claimed (again, see Berggren, page 16, lines 23-26, as previously cited, where the registration request sent from the terminal 262, which corresponds to the claimed client, includes subscriber information that is read from SIM card 160, noting that the SIM card includes the subscriber identity and is a part of the mobile station, and therefore, the subscriber identity must be received form the mobile station at the client/terminal before it is sent in the request as described in the cited portion).
Applicant further argues that Turtiainen does not disclose receiving the subscriber identity at a mobile client from a mobile station (page 3 of the present response) and that Bilgic also does not disclose or suggest receiving a subscriber at a mobile client from a mobile station (page 4 of the present response). However, because this limitation is disclosed by at least the cited portions of Berggren, as described above, these arguments are moot.
Applicant additionally argues that the motivation to combine the teachings of Berggren and Turtiainen is insufficient because "each reference alone provides a sufficient solution for using a mobile phone and/or SIM authentication" (pages 3-4 of the present response). However, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Therefore, the Examiner believes that the motivation as cited in the previous Office actions, namely to free a user from the need to carry a separate authentication device or many different authentication devices (see Turtiainen, column 5, lines 20-42) is a recognition expressly in the prior art that some advantage or expected beneficial result would have been produced by the combination, which is the strongest rationale for combining references (see MPEP § 2144). The Examiner additionally believes that one of ordinary skill in the art would have been motivated to make the combination because the substitution of one known element (the client of Berggren) for another (the mobile client of Turtiainen) would have yielded predictable results to one of ordinary skill in the art at the time the invention was made, namely the result of a more portable system with both the client and mobile station being mobile.
Applicant also argues that "there is no need to add further authentication [as taught by Bilgic] to the teachings of Berggren and Turtiainen" because "the authentication mechanisms disclosed by Bilgic are similar to the authentication techniques of Berggren and Turtiainen, therefore Bilgic does not provide for any additional teachings with respect to the cited references" (pages 4-5 of the present response). The Examiner first notes that, as previously described in the previous Office action, although Berggren and Turtiainen disclose using a challenge reponse protocol for authentication the user, neither of those references explicitly discloses the specific use of a second secret as claimed, and therefore Bilgic was cited for a more specific teaching of the exact claim limitations. The Examiner alternately notes that Applicant appears to at least imply that the limitations of which Bilgic was relied for disclosure are actually to be found within or at least inherent in the disclosures of Berggren and Turtiainen.